

Appl. No. : 10/786,620
Filed : February 24, 2004

REMARKS

The February 6, 2006 Final Office Action was based upon pending Claims 1–13, 16–23, 29–37 and 47–51. By this Response, Applicant is amending Claims 1–4, 7, 10, 12, 16, 18–23, 29, 34, 47 and 51 and is cancelling Claim 8 without prejudice or disclaimer. Claims 5, 6, 9, 11, 13, 17, 30–33, 35–37 and 48–50 remain as originally filed or as previously presented, and new Claims 52–56 have been added.

Thus, after entry of this Amendment, Claims 1–7, 9–13, 16–23, 29–37 and 47–56 are pending and presented for further consideration. In view of the foregoing amendments and the remarks set forth below, Applicant respectfully submits that Claims 1–7, 9–13, 16–23, 29–37 and 47–56 are in condition for allowance.

SUMMARY OF OBJECTIONS AND REJECTIONS

The February 6, 2006 Final Office Action rejected Claims 1–5, 7–11, 16, 17, 29, 30, 32–37 and 47–50 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,815,647 to Buckland et al. ("Buckland") in view of U.S. Patent No. 5,943,482 to Culley et al. ("Culley").

Claims 6, 12, 13, 18–23, 31 and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Buckland in view of Culley and in further view of U.S. Patent No. 5,819,042 to Hansen ("Hansen").

CLAIMS CANCELLED BY PREVIOUS AMENDMENT

Applicant notes that the Cover Sheet of the February 6, 2006 Final Office Action indicated that Claims 1–51 were pending in the application. Claims 14, 15, 24–28 and 38–46, however, were cancelled in Applicant's Amendment mailed on November 29, 2005. The Final Office Action also detailed various rejections of these cancelled claims. Applicant respectfully requests that the identification of the pending claims be corrected in any subsequent communication.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

The Final Office Action rejected Claims 1–5, 7, 9–11, 16, 17, 29, 30, 32–37 and 47–50 as being unpatentable over Buckland in view of Culley. Claims 6, 12, 13, 18–23,

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31 and 51 were rejected as being unpatentable over Buckland in view of Culley and in further view of Hansen.

In view of the foregoing amendments and for at least the reasons set forth below, Applicant respectfully disagrees and requests reconsideration of the aforementioned claims.

Amended Independent Claim 1

Focusing on amended independent Claim 1, one embodiment of Applicant's invention includes an electronic device comprising one or more slots configured to receive at least one peripheral adapter and a software module configured to provide a graphical user interface ("GUI") that indicates whether a selected operational slot in the electronic device is configured to support a hot input function. The electronic device further includes one or more hardware modules configured to control the power to the selected operational slot.

Neither Buckland, nor Culley, nor a combination thereof, teaches or suggests the electronic device recited in amended Claim 1. For example, the cited references do not teach or suggest a software module configured to provide a GUI that indicates whether a selected operational slot in the electronic device is configured to support a hot input function.

Buckland

Buckland is directed to a computer system that allows a user to identify which of a plurality of feature cards has issued an error signal. The February 6, 2006 Final Office Action asserts that Buckland teaches a "software module configured to provide a GUI" because a user of the Buckland system can select an icon when the user wants to initiate a process for changing the system hardware configuration (see, e.g., col. 7, lines 47-53).

The Final Office Action acknowledges, however, that "Buckland does not teach a GUI indicating whether a selected slot in the electronic device is configured to support a hot insertion function." Applicant agrees and further submits that Buckland does not teach or suggest that the icon indicates, or is capable of indicating, any type of

information relating to the configuration characteristics of a selected slot in the electronic device.

Culley

Culley is directed to a system that regulates delivery of power to a connector for a circuit card based on the engagement of a clamp configured to prevent removal of the card. Culley does not teach or suggest indicating "whether a selected operational slot in [an] electronic device is configured to support a hot input function," as recited by amended Claim 1 (emphasis added). Rather, the portions of Culley cited by the Final Office Action concern the identification and/or isolation of certain faulty (i.e., defective or failed) slots (see, e.g., col. 89, lines 1–3 and 20–29), such as slots involved in a bus hang (see, e.g., col. 92, lines 37–39). Culley does not appear to provide information to a user regarding the configuration of operational, or functioning, slots.

Combination of Buckland and Culley

In addition to not teaching or suggesting each limitation of amended Claim 1, there is no motivation to combine the teachings of Buckland and Culley to teach the invention recited by Claim 1. For instance, in response to Applicant's previous arguments, the Final Office Action states:

Buckland teaches a GUI used for configuring a hot insertion into a slot in an electronic device. Culley teaches software that . . . indicates whether a selected slot is configured to support a hot input function. Thus, the combination teaches a GUI that indicates whether a selected slot in the electronic device is configured to support a hot input function.

The Final Office Action later states that it would have been obvious to combine Buckland and Culley because "this would have allowed for preventing using a slot that cannot accept a new device."

First, the Final Office Action provides no explanation how the software of Culley, which is used to identify faulty slots, is to be combined with the icon of Buckland to teach or suggest "a software module configured to provide a graphical user interface that indicates whether a selected operational slot in the electronic device is configured to support a hot input function." Rather, Applicant submits that a skilled artisan at the time of the invention would not have looked to an icon to display such information.

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Second, M.P.E.P. § 2143.01 requires that the motivation to combine references comes from: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and/or (3) the knowledge of persons of ordinary skill in the art. The Final Office Action's stated motivation to combine the references does not appear to relate to any of the acceptable sources for a motivation to combine. Rather, the combination of the references by the Final Office Action appears to be based on hindsight to piece together prior art to show the teaching of Applicant's invention. It is not permissible to reconstruct the claimed invention from the prior art by using the claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985); see also M.P.E.P. § 2145(X)(A).

Summary

Because the combination of Buckland and Culley is improper and because, even if combined, the cited references do not teach or suggest a software module configured to provide a GUI that indicates whether a selected operational slot in an electronic device is configured to support a hot input function, Applicant asserts that amended Claim 1 is patentably distinguished over the cited art. Applicant, therefore, respectfully requests allowance of amended Claim 1.

Independent Claims 4, 16, 29, 34 and 47

Independent Claims 4, 16, 29, 34 and 47 are believed to be patentable for reasons similar to those set forth with respect to the patentability of independent Claim 1 and for the different aspects recited therein.

Dependent Claims 2, 3, 5, 7, 9–11, 17, 30, 32, 33, 35–37 and 48–50

Claims 2 and 3 depend from independent Claim 1 and are believed to be patentable for the additional features recited therein.

Claims 5, 7 and 9–11 depend from independent Claim 4 and are believed to be patentable for the additional features recited therein.

Claim 17 depends from independent Claim 16 and is believed to be patentable for the additional features recited therein.

Claims 30, 32 and 33 depend from independent Claim 29 and are believed to be patentable for the additional features recited therein.

Claims 35–37 depend from independent Claim 34 and are believed to be patentable for the additional features recited therein.

Claims 48–50 depend from independent Claim 47 and are believed to be patentable for the additional features recited therein.

Amended Independent Claims 12, 18, 21 and 51

Independent Claims 12, 18, 21 and 51 are believed to be patentable for reasons similar to those set forth with respect to the patentability of independent Claim 1 and for the different aspects recited therein. That is, the cited art, including Hansen, does not teach or suggest a graphical user interface that indicates whether a selected operational, or functioning, adapter location is configured to support a hot input function.

Dependent Claims 6, 13, 19–23, 31

Claim 6 depends from independent Claim 1 and is believed to be patentable for the additional features recited therein. For instance, neither the cited art nor common knowledge in the art teaches or suggests a software module configured to provide a graphical user interface that indicates whether a selected operational slot in an electronic device is configured to support a hot input function.

Claim 13 depends from independent Claim 12 and is believed to be patentable for the additional features recited therein.

Claims 19 and 20 depend from independent Claim 18 and are believed to be patentable for the additional features recited therein.

Claims 22 and 23 depend from independent Claim 21 and are believed to be patentable for the additional features recited therein.

Claim 31 depends from independent Claim 29 and is believed to be patentable for the additional features recited therein. For instance, neither the cited art nor common knowledge in the art teaches or suggests a user interface module configured to indicate whether or not a selected functioning adapter location is configured to

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support a hot input function and comprising a series of screen displays exhibiting steps to hot input an adapter.

APPLICANT'S TRAVERSAL OF OFFICIAL NOTICE

With respect to Claims 6, 12, 18, 21, 24, 31 and 51, the Examiner takes Official Notice that "step by step instructions are common as evidenced by Hansen Figures 4–8." The Examiner further states that "[i]t would have been obvious to include several screens with step by step instructions because this would have allowed for minimally trained personnel to control the insertion/removal of the device(s)."

Applicant respectfully traverses the Examiner's assertion of Official Notice. In particular, Figures 4–8 of Hansen appear to illustrate user interfaces depicting a map of network devices and user interfaces for obtaining information from a user regarding the configuration of a particular device (see, e.g., col. 14, lines 21–36). Thus, Applicant respectfully requests documentary evidence supporting the Examiner's assertion that is well known to provide a graphical user interface for displaying information (such as, for example, through a plurality of screen displays) regarding steps for hot inputting an adapter. Absent such documentation, Applicant respectfully requests the Examiner to withdraw the assertion of Official Notice as support for any rejection.

NEW CLAIMS 52–56

New Claims 52–56 have been added to more fully define the Applicant's invention and are believed to be fully distinguished over the prior art of record.

REQUEST FOR TELEPHONE INTERVIEW

Pursuant to M.P.E.P. § 713.01, in order to expedite prosecution of this application, Applicant's undersigned attorney of record hereby formally requests a telephone interview with the Examiner as soon as the Examiner has considered the effect of the arguments presented above. Applicant's attorney can be reached at the general office number listed below.

CONCLUSION

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be

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resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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